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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,735	12/01/2003	Gregory J. Boss	YOR920030442US1	3079

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EXAMINER	
FLEISCHER, MARK A	
ART UNIT	**PAPER NUMBER**
3624	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/725,735	BOSS ET AL.	
	Examiner	Art Unit	
	MARK A. FLEISCHER	3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 January 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *31-60* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *31-60* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. This non-final office action is in reply to the amendments and Request for Continued Examination filed on 21 January 2009.
2. Claim 1 has been cancelled.
3. Claims 2–30 have been previously cancelled.
4. Claims 31–60 have been added.
5. Claims 31–60 are currently pending and have been examined.

Continued Examination Under 37 CFR 1.114

6. A request for continued examination under 37 CFR §1.114, including the fee set forth in 37 CFR §1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR §1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR §1.114. Applicant's submission filed on 7 August 2008 has been entered.

Response to Amendments

7. All previously filed claims have been cancelled. Therefore, no outstanding objections or rejections are withdrawn or maintained.

Response to Arguments

8. Applicant has not offered any substantive arguments with respect to the previously submitted and cancelled claims or with respect to the new claims submitted to respond to.

Claim Objections

9. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

10. Misnumbered claim 53 has been incorrectly renumbered 25 which was cancelled. This appears to be an obvious typographical error. For purposes of review in this Office Action, Examiner will interpret this claim as being numbered 53. Applicant is required to cure this defect.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. §101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 31-60 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

- The preamble of independent Claim 31 is not a process, machine, manufacture, or composition of matter, or any improvement thereof wherein a process claim is sufficiently tied to another statutory class.
- The preamble of independent Claim 41 is similarly not drawn to statutory subject matter because
- The preamble of independent Claim 51 is similarly not drawn to statutory subject matter because a service directed to non-statutory subject matter.

Based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or

materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876). An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a §101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 31–35, 39, 41–45, 49, 51–55 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minneman (US 6243740 B1) in view of Williams (US 20020178442 A1).

Claims 31, 41 and 51

Note, that although claims 31, 41 and 51 may have slightly different wording, preambles or structure, they have the same scope and so are addressed together. Minneman, as shown, describes and/or discloses the following limitations.

- *A method for selecting a logical branch in a storyline among a plurality of available storyline branches* (Minneman, in at least the abstract states: "The public […] communicates, via the device or devices, a signal indicative of their reactions and for effecting a prospective scene selection in the document content that, in turn will vary the narrative." (emphasis added) where 'communicates …indicative…for effecting'

corresponds to *a method for selecting*. Minneman, in at least [0005] (column 1, lines 50-1), further describes systems and methods that "have been devised for the private direction of a narrative story through a number of alternative paths and endings […]" (emphasis added) where 'paths' corresponds to *available storyline branches.*),

Minneman does not specifically describe obtaining votes, *per se,* but Williams, as shown, does.

based on voters' votes (Williams, in at least [0030] states: "Two weeks later the audience votes for Ending 1." (emphasis added) where 'audience votes' corresponds to *voters' votes.*), *comprising:*

- *accumulating the votes from the voters* (Williams, in at least [0007]: states: "Audience feedback that influences programming content may be collected directly from weekly audience polling […]" (emphasis added) which corresponds to the limitation.)*;*
- *calculating a total for the accumulated votes* (this is inherent in 'audience polling', *i.e.,* the very notion of 'polling' and 'voting' directly implies tallying or summing or counting votes)*; and*
- *selecting a winning tally that corresponds to a storyline branch, based on the total of the accumulated votes* (Williams, in at least [0023-30] states: "Two days later, the audience answers are tallied and the most popular answers are […] Two weeks later the audience votes for Ending 1." (emphasis added) where 'are tallied' corresponds to *accumulated votes* and 'most popular' corresponds to *selecting a winning tally…*and 'audience votes for Ending 1' corresponds to the winning *storyline branch*.).

Minneman's and Williams' inventions both pertain to utilizing audience participation in modifying the evolution of a storyline. Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention to combine the inventions of Minneman and Williams to create a more interactive system as this affords producers an opportunity to increase audience participation and thereby garner greater commercial success for their advertising sponsors.

Claims 32, 42 and 52:

Minneman does not specifically describe and/or disclose the following limitation, but Williams, as shown, does.

- *transferring the storyline branch to a content branching system* (Williams, in at least [0021] states: "[T]he [Online Request] is storyline-content that originates within the audience's imagination and then later is culled and incorporated by the staff into the show's storyline." (emphasis added) where 'storyline-content' corresponds to *storyline branch* and 'culled ... by the staff' corresponds to *a content branching system* that manages the storyline branch.)

Minneman's and Williams' inventions both pertain to utilizing audience participation in modifying the evolution of a storyline. Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention to combine the inventions of Minneman and Williams to create a more interactive system as this affords producers an opportunity to increase audience participation and thereby garner greater commercial success for their advertising sponsors.

Claims 33, 43 and 53:

Minneman does not specifically describe and/or disclose the following limitation, but Williams, as shown, does.

- *displaying the transferred storyline branch* (Williams, in at least [0006]: states: "[T]he invention queries will be prescribed to directly determine the show's story line […]" (emphasis added) where 'show's story line' corresponds to *displaying …*).

Minneman's and Williams' inventions both pertain to utilizing audience participation in modifying the evolution of a storyline. Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention to combine the inventions of Minneman and Williams to create a more interactive system as this affords producers an opportunity to increase audience participation and thereby garner greater commercial success for their advertising sponsors.

Claims 34, 44 and 54:

Minneman further describes and/or discloses the following limitation.

- *selectively excluding votes for a specific storyline branch* (Minneman, in at least [0028] (col. 8, line 55) states: "Alternative embodiments of the invention include directional voting, wherein custom antennas with directional qualities will attend to signals coming from one set of viewers whilst rejecting signals from another." (emphasis added) where 'rejecting signals from another' corresponds to *selectively excluding*. Note that in Minneman in at least [0008] (col. 2, line 10), reference is specifically made to story branches, hence, the aforementioned 'rejecting … from another' corresponds to effectuating changes in the storyline by possibly excluding certain voters' votes.)

Claims 35, 45 and 55:

Minneman further describes and/or discloses the following limitation.

- *selectively excluding votes for a specific storyline branch comprises excluding the votes within a predetermined period of time before the specific storyline branch occurs* (Minneman, in at least claim 9 claims "monitoring the signals in accordance with predetermined conditions for recognizing the reaction by a predominant public interest expressed as a voting measured by the plurality of signals;" (emphasis added) and in dependent claim 11 states: "the video elements including tokens for indicating a time for the communicating of the signals." (emphasis added) where 'predetermined conditions' pertain to 'voting' and within some '[indicated time]'. Note that this voting scheme includes the exclusion capability described in Minneman [0028] (col. 8, line 55) and thereby meets the limitation.

Claims 39, 49 and 59:

Minneman does not specifically describe and/or disclose the following limitations, but Williams, as shown, does.

- *saving a record of the storyline branch for later replay* (Williams, in at least [0030] states: "Two weeks later the audience votes for Ending 1. The show is now in the

hands of the Editor who is instructed to use Ending 1 for the "Answering Machine Dilemma" scene." (emphasis added) where the 'instruction' and reference to an 'Editor', *ipso facto* requires some method of *saving a … storyline … for later replay.*)

Minneman's and Williams' inventions both pertain to utilizing audience participation in modifying the evolution of a storyline. Williams' invention also indicates some inventory of scenes for later use. Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention to combine the inventions of Minneman and Williams to create a more interactive, and efficient system as this affords producers an opportunity to increase audience participation and thereby garner greater commercial success for their advertising sponsors.

15. Claims 36–38, 46–48 and 56–58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minneman/Williams as applied to claims 1, 11 and 21 above, and further in view of Chisholm (US 5400248 A).

Claims 36, 46 and 56:

Minneman/Williams also describes and/or discloses that *votes are weighted* where Williams, in at least [0053] states: "As an incentive for fan club membership, fans may be granted weighted voting rights." (emphasis added). Minneman/Williams, however do not describe and/or disclose *determining if the votes are weighted,* where the act of *determining* is not specifically mentioned. Chisholm, however, as shown, does describe and/or disclose this element of the limitation. Chisholm, in claims 38 and 39 claim a method where "determining which voter input signals were most critical in obtaining a prescribed set of results; […] determining which voter input signals were least critical in obtaining a prescribed set of results […]" (emphasis added) where the noted criticality corresponds to a weighting. Note that Chisholm also specifically mentions weighted voting as in [0017]: "Votes need not be weighted equally." and further in [0011] that "the vote administrator weights voter x's vote by the factor W(x) …" where the 'administrator', *ipso facto, determines* whether a particular vote is to be weighted.

Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention to combine the teachings of Minneman/Williams with that of Chisholm to describe a

flexible system that allows management of audience choices and how they are to be weighted because it creates a more interactive system and affords producers an opportunity to increase audience participation and thereby garner greater commercial success for their advertising sponsors.

Claims 37, 47 and 57:

Minneman/Williams do not specifically describe and/or disclose the following limitation, but Chisholm, as shown, does.

- *if the votes are weighted, selectively multiplying the votes by respective weight factors* (See the rejections of the above claims 36, 47 and 57 wherein Chisholm specifically refers to weighting factor "W(x)").

Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention to combine the teachings of Minneman/Williams with that of Chisholm to articulate a flexible system that allows management of audience choices and how they are to be weighted because it creates a more interactive system and affords producers an opportunity to increase audience participation and thereby garner greater commercial success for their advertising sponsors.

Claims 38, 48 and 58:

Minneman and Williams do not specifically describe and/or disclose the following limitations, but Chisholm, as shown, does.

- *determining if additional votes remain to be accumulated; and wherein if additional votes remain to be accumulated, repeating an accumulation of the votes until all the votes have been incremented* (Chisholm, in at least [0066] states: "Then the system passes through the list again and evaluates all new votes […] This process is repeated until an iteration occurs on which no new votes are determined. If all votes in the group have been determined by this process (step I), the system is finished and the results are displayed." (emphasis added) where 'the system' in 'repeating a process' corresponds to *repeating an accumulation*. Also,

Chisholm claim 12 specifically refers to *accumulating* where "controller means, coupled to said computer system and said plurality of voting units, for accepting or rejecting additional voter input signals […]" (emphasis added) where the 'controller means' that '[accepts] or [rejects] additional voter [ ] signals' corresponds to adding additional votes.

Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention to combine the teachings of Minneman/Williams with that of Chisholm to articulate a flexible system that allows management of audience choices and how they are to be weighted and also to ensure that all relevant voters' votes are tabulated because it creates a more interactive and *accurate* system and thus affords producers an opportunity to increase audience participation, in a reliable manner, and thereby garner greater commercial success for their advertising sponsors.

Claims 40, 50 and 60:

Minneman and Williams do not specifically describe and/or disclose the following limitations, but Chisholm, as shown, does.

- *the votes are weighted based on a graduated ticket pricing* (Williams, in at least [0006] specifically refers to a "movie". In at least [0053], Williams further states: "Fan club membership, subscription newsletters (on and offline) and other premium fan portal services. As an incentive for fan club membership, fans may be granted weighted voting rights." (emphasis added) where a 'fan club' corresponds to a movie goer, and 'premium … portal services' corresponds to a particular level and *graduated ticket pricing* which are *weighted* in a fashion based on 'premium [ ] services' obtained such as entrance to a movie theater.)

Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention to combine the teachings of Minneman/Williams with that of Chisholm to articulate a flexible system that allows management of audience choices and how they are to be weighted and also to ensure that all relevant voters' votes are tabulated because it creates a more

interactive system, one which allows participants the opportunity to influence the outcome based on an admission fee (ticket) and thus affords producers an opportunity to increase audience participation and thereby garner greater commercial success for their advertising sponsors.

Conclusion

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Mark A. Fleischer** whose telephone number is **571.270.3925.** The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Bradley Bayat** whose telephone number is **571.272.6704** may be contacted.

The prior art made of record and not relied upon that is considered pertinent to applicant's disclosure are:

- Logan, et al. (US PgPub 20030093790 A1)
- Wind (US PgPub 20040009813 A1)

both of which teach methods for enabling divergent storylines and /or audience participation wherein storylines and/plots are dynamically modified.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair <http://pair-direct.uspto.gov >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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or faxed to **571-273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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Mark A. Fleischer
/Mark A Fleischer/
Examiner, Art Unit 3624 20 February 2009

/Bradley B Bayat/
Supervisory Patent Examiner, Art Unit 3624